INDEX

	Page
Opinion below	1
Jurisdiction	1
Question presented	2
Statutes involved	2
Statement	3
Argument	5
Conclusion	7
Appendix	9

CITATIONS

Cases:	
Baldwin Rubber Co. v. *Paine & Williams Co.*, 99 F. (2d) 1	6
Britannia, The, 153 U. S. 130	6
Fullagar, Re, 40 App. D. C. 510	6
General Talking Pictures Corp. v. *Western Electric Co.*, 304 U. S. 175	7
Keller v. *Adams-Campbell Co.*, 264 U. S. 314	7
Layne & Bowler Corp. v. *Western Well Works, Inc*, 261 U. S. 387	7
Miller v. *Brass Co.*, 104 U. S. 350	5
Topliff v. *Topliff*, 145 U. S. 156	5, 6
United States v. *Commercial Credit Co.*, 286 U. S. 63	7
Statutes:	
Revised Statutes, Sec. 4915, as amended by the Act of March 2, 1927, c. 273, Sec. 117, 44 Stat. 1335, and Act of March 2, 1929, c. 488, Sec. 2 (b), 45 Stat. 1475 (35 U. S. C. Sec. 63)	4, 9
Revised Statutes, Sec. 4916, as amended by the Act of May 24, 1928, c. 730, 45 Stat. 732 (35 U. S. C. Sec. 64)	4, 5, 10

In the Supreme Court of the United States

OCTOBER TERM, 1940

No. 414

BOOTH FISHERIES CORPORATION, PETITIONER

v.

CONWAY P. COE, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINION BELOW

The District Court entered judgment (R. 116) without an opinion. Its findings of fact and conclusions of law appear at pages 112–115 of the record. The opinion of the United States Court of Appeals for the District of Columbia (R. 119–121) is not yet officially reported.

JURISDICTION

The judgment of the Court of Appeals for the District of Columbia was entered May 13, 1940 (R. 121). A motion for a rehearing was denied on

June 24, 1940 (R. 122). The petition for a writ of certiorari was filed September 10, 1940. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTION PRESENTED

Petitioner is the assignee of a patent on a food freezing process. Nine years after the issuance of the original patent, petitioner applied for a reissue thereof with certain broader and different claims copied from patents subsequently issued to other parties, on the ground that the error in omitting such claims from the original patent arose through inadvertence, accident, or mistake. The question is whether the evidence supports the finding of the District Court that the error in omitting the claims from the original patent did not arise through inadvertence, accident, or mistake.[1]

STATUTES INVOLVED

The applicable portions of the statutes involved are set forth in the Appendix, *infra,* pp. 9–11.

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[1] The District Court found, in addition, that a delay of over nine years between the time the original patent was issued and the date of the application for reissue was sufficient of itself to defeat the application for reissue (R. 114–115). The court below, however, affirmed solely upon the ground that there had been no inadvertence, accident or mistake (R. 121).

STATEMENT

The pertinent facts may be summarized as follows:

The petitioner brought this suit seeking to have Cooke patent No. 1,614,455 reissued with claims in addition to those included in the original patent (R. 112). The Cooke patent, issued January 18, 1927, was assigned to petitioner on February 20, 1936 (R. 112). The invention of the patent as claimed relates to stacking hollow-walled, food-product containers on each other, so that each forms a cover for the one below it, and freezing the product by means of a refrigerant flowing through the hollow walls on all sides of the product (R. 5–10, 112).

The application for reissue of the Cooke patent was filed by petitioner on July 11, 1936, nearly nine and one-half years after the issuance of the original patent (R. 112). It contained, in addition to the 31 claims of the original patent (R. 1, 63), claims copied from various patents which had been issued to others between five and six years prior to the filing of the reissue application (R. 112). These copied claims involve freezing the products between two flat plates and do not deal with walled containers (R. 112). They are broader than any of the original claims of the Cooke patent; so far as appears, during the prosecution of his application for the original Cooke patent, the applicant did not contemplate so broad an invention as expressed in the copied claims (R. 112, 115, 120).

The affidavit filed in the Cooke reissue application alleged, in an attempt at showing the inadvertence, accident, or mistake made a prerequisite to reissue by R. S. 4916, that the copied claims "might and should have been made" in the application for the original patent but for Cooke's unfamiliarity with patent procedure and for the "mistake" of his attorney. It also alleged that the *Patent Office* was guilty of inadvertence, accident, or mistake in failing to set up interferences between the issued patent to Cooke and the applications for the patents in which the copied claims were granted (R. 112–113).

The application for reissue was rejected by an examiner of the Patent Office (R. 63–64). The Board of Appeals of the Patent Office, on appeal, affirmed the decision of the examiner (R. 64–66) and, on petition for rehearing, adhered to its decision (R. 66–67). Petitioner thereupon instituted this proceeding in the District Court (R. 68–72) pursuant to R. S. 4915, *infra*, p. 9.

The District Court, upon a consideration of all the evidence, concluded that the alleged defects in the Cooke patent did not arise from inadvertence, accident, or mistake, within the meaning of R. S. 4916 (R. 114). Accordingly, it held that the petitioner was not entitled to a reissue of Cooke patent No. 1,614,455, containing the claims set out in the bill of complaint (R. 115), and dismissed the complaint (R. 116). On appeal, the Court of Appeals for the District of Columbia affirmed (R. 121).

ARGUMENT

No conflict of decisions exists. The pivotal question here is simply whether the alleged defect in Cooke patent No. 1,614,455, namely, the failure to obtain the copied claims now sought by reissue, arose from inadvertence, accident, or mistake within the meaning of Section 4916 of the Revised Statutes.[2] The District Court found (R. 114) against petitioner on this issue. So long as that finding stands, no other issue has any bearing on the merits of the case. We submit that this finding is correct and that, in any event, there is no occasion for review in this Court.

(a) The evidence discloses that the copied claims are broader and different from those covered by the original patent (R. 112, 115, 120) and that the file record in the original patent contained no evidence that Cooke contemplated freezing in any manner other than in walled containers, which required thawing to loosen the product (R. 8, 99, 112, 115, 120, 121). The nine-year delay in seeking reissue and the six-year delay in copying the added claims each suggests that the claims now sought on

[2] It is clear that a patent may be reissued only when the patentee had intended to claim a concept embodied in his original patent and had failed to make such claim as a result of inadvertence, accident, or mistake. *Miller* v. *Brass Co.*, 104 U. S. 350; *Topliff* v. *Topliff*, 145 U. S. 156. A reissue will not be granted where the only error was a failure to make a claim as broad as it might have been in the light of the subsequent course of improvement. *Miller* v. *Brass Co.*, *supra*, p. 351.

reissue were an afterthought (R. 112, 113, 115, 121). And Cooke's affidavit, when examined in the light of all the evidence, does not compel a different conclusion. Compare *Re Fullagar,* 40 App. D. C. 510. Accordingly, we submit, the finding of the District Court (R. 114) on the pivotal issue is supported by substantial evidence.[3]

(b) Petitioner argued before the Court of Appeals that Cooke had in mind the broad concept of the claims sought by reissue and intended to embody it in his original application, and that his failure to do so was the result of inadvertence, accident, or mistake (R. 120). But the court pointed out (R. 120–121) that the record of the original patent failed to disclose any such idea or intent. The court made no finding that the claims refused involved new matter or were not readable upon the structure disclosed in the Cooke patent, and discussed the record only with respect to considerations showing that there was no inadvertence, accident, or mistake. Petitioner's contention (Pet. 7–8) that the court departed from the accepted and usual course of procedure is therefore without merit.

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[3] The question of inadvertence, accident, or mistake is one of fact. *Topliff* v. *Topliff*, 145 U. S. 156, 168–169, 171. Its real nature is not changed because the District Court labeled it a conclusion of law. *The Britannia*, 153 U. S. 130; *Baldwin Rubber Co.* v. *Paine & Williams Co.*, 99 F. (2d) 1, 2 (C. C. A. 6th).

(c) The issue whether there was inadvertence, accident, or mistake—which is an issue of fact—is similar to the issues of patentability, infringement, and scope of claim which ordinarily are not reviewed by this Court. *Keller* v. *Adams-Campbell Co.*, 264 U. S. 314, 319; *Layne & Bowler Corporation* v. *Western Well Works, Inc.*, 261 U. S. 387; *General Talking Pictures Corp.* v. *Western Electric Co.*, 304 U. S. 175. There is no more reason for review in the case at hand.

(d) In addition, we submit, the record discloses (R. 121) [4] that the finding of the District Court on the pivotal issue was passed upon and concurred in by the court below. Accordingly, since both courts below have agreed on the pivotal issue of fact, there is no occasion for further review here. *United States* v. *Commercial Credit Co.*, 286 U. S. 63, 67.

CONCLUSION

The decision of the court below was correct and turns upon a finding of fact concurred in by two lower courts. There is no conflict and no question of general importance. It is therefore respect-

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[4] The Court of Appeals for the District of Columbia stated (R. 121):

"The failure of the application to disclose the concept of freezing between two flat refrigerating surfaces is so plain as almost to compel the inference that it was not due to 'inadvertence, accident, or mistake.' Accordingly, the District Court's finding to that effect is fully supported by the evidence."

fully submitted that the petition for a writ of certiorari should be denied.

FRANCIS BIDDLE,
Solicitor General.

FRANCIS M. SHEA,
Assistant Attorney General.

PAUL A. SWEENEY,
Special Assistant to the Attorney General.

JOSEPH Y. HOUGHTON,
EDWIN E. HUDDLESON, Jr.,
Attorneys.

W. W. COCHRAN,
Solicitor for the Patent Office.

SEPTEMBER 1940.